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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/943,799

**Applicant(s)**

GLASGOW, JINAN

**Examiner**

ANH LY

**Art Unit**

2162

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/08/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/IC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

#### **DETAILED ACTION**

1. This Office Action is response to Applicant's AMENDMENT and RCE filed on 12/08/2008.

#### ***Request for Continued Examination (RCE)***

2. The request filed on 06/21/2007 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/943,799 is acceptable and a RCE has been established. An action on the RCE follows.
3. Claims 6 and 18-19 cancelled.
4. Claims 1-5 and 7-17 are pending in this Application.

#### ***Response to Arguments***

5. This is a new ground(s) of rejection due to claimed invention recited in claims 1, 11, 16 and 17 having 35 U.S.C. § 101 issues. Examiner removes the previous applied references : RIVETTE et al. and Grainger.

TRAN (Pub. No.: US 2006/0190807 A1) teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the

claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim tree.

### ***Claim Objections***

6. Claim 7 is objected to because of the following informalities: In the first line of claim 7, "the system according to claim 6," is replaced with "the system according to claim 1,". Because the existing dependency of claim 7 is pointing to the cancelled claimed, claim 6. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-5 and 7-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 16 are "system" claims that have "input device" as voice (see instant specification page 7, lines 6-8), non-statutory subject matter, signal per se. It

fails to fall within at least one of the four categories of patentable subject matter with the statutory (statutory categories: Process, Machine, Manufacture and Composition of Matter) (MPEP 2106 [R-5] - See, e.g., Alappat, 33 F.3d at 1542, 31 USPQ2d at 1556; and Warmerdam, 33 F.3d at 1358, 31 USPQ2d at 1757 (Fed. Cir. 1994)).

Claims 11 and 17 are "method" claims that are lacking a physical transformation or lacking of being tied to an apparatus, machine or hardware in the body of the claims during the process steps. In order to qualify as a 101 statutory process, the claim should positively recite the other statutory class to which it is tied, or positively recite the subject matter that is being physically transformed (see MPEP § 2106.IV.B; and 2106 (IV)(C0(2))(1) & (2) & (a) & (b) & (c)) para). Also, the "tangible medium" is not well specified or defined in the instant specification. It is interpreted such as "transmission media", signal per se.

an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer- readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Because in the line 18 of claim 1, and line 23 of claim 11, the "may be" are not clear. Applicant(s) is(are) advised to amend the claim to provide a clear and concise language to the claim in order for one of ordinary skill in the art to make and use the claimed invention.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over TRAN (Pub. No.: US 2006/0190807 A1; Continuation of application No. 09/792,828, filed on FEB. 24, 20001) in view of Rivette et al. (Pub. No.: US

2007/0208669 A1, Continuation of application No. 11/178,367, filed on JUL. 12th, 2005, which is a Continuation of application No. 09/545,608, filed on APR. 7th, 2000, hereinafter as RIVETTE).

With respect to claim 1, TRAN teaches a system for drafting a patent application and assessing technological information on at least one computer (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: para 0006, 0010 and 0132-0133), the system comprising:

at least one input device connected to the at least one computer for inputting information from at least one user (inputting from one of client computers: fig. 1, items 104 and 106, para 0035);

at least one processing means for generating a diagrammatic representation of an invention (using graphical user interface and software for assisting the user in generating a patent application: para 0042-0043 and fig. 2A and 2C), wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the invention based upon the information inputted by the at least one user (fig. 3B a claim tree, para 0068), and for automatically generating a document for filing as a patent application (automatically generating a patent application: fig. 2's para 0042), including specification and claims, based upon the information inputted by the at least one user and additional text-based detailed information that is organized consistent with the diagram (technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, para

0008, 0016, 0046 and 0101-0103); wherein the hierarchical component categorization includes at least one key component and at least one subcomponent related thereto, wherein the diagrammatic representation of the components and subcomponents together provides an indication of what may be claimed in a patent application (independent claims and dependent claims: in fig. 3B claim tree and para 0053-0054); and

at least one output device connected to the at least one computer for outputting the automatically generated diagrammatic representation of an invention (the claim tree is displayed on the desktop screen, output device: para 0127 and fig. 3B).

TRAN teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim tree. The user such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, para 0052) and including at the step 312, the system diagramming the elements of a claim (para 0068-0079) and fig. 3B illustrating



the diagrammed claim, showing the hierarchy of elements (para 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the diagrammatic representation comprises graphical component structure and textual component content associated with each component such that for each component, the graphical component structure includes the textual component content and wherein the text-based information and the diagram components are automatically directly linked by being visually integrated with one another within the graphical component structure as claimed.

However, RIVETTE teaches image file and text file are presentations of patent (para 0429); the patent is represented by icon (para 0980 and fig. 73 and 164); claim tree (fig. 185; para 1368-1369); hyperlinking using a linked list of nodes for switching to view the desired component (para 1231-1233; also para 1236-1240). This is the same as the graphical component of a patent including drawings, claims, abstract, summary and detail specification and is illustrated and displayed under a hierarchical tree with graphical component structure (see figs 164 and 185) and classification or categorization the patent/document (para 0727, 1434, and 2080).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a source patent and claim as well (RIVETTE's para 1368-1368; fig. 164 and 185), into the system of TRAN for the purpose of having

tools including modules to track and process of Patent or Intellectual property related transaction such as license agreements, therefore, enabling user to use automated tools that automatically process patent related information for making corporate business decision (RIVETTE's para 0003-0008 and 0020-0021).

With respect to claim 2, TRAN teaches wherein the diagram is modifiable by the at least one user and the diagram hierarchical component categorization and related text-based detailed information is automatically updated based upon the user modifications (the text of a patent application is enabling to update or edit: para 0044 and claim tree is also able to move or to modify (drag/drop claims): para 0068).

With respect to claim 3, TRAN teaches wherein the at least one key component includes a multiplicity of components (such as one independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: para 0068 or a patent application has background, summary, description, drawings and claims components: para 0008, 0016 and 0044-0045).

With respect to claim 4, TRAN teaches wherein the at least one subcomponent further includes at least one sub-subcomponent (independent and dependent claims: claim tree: para 0068 and 0053-0054).

With respect to claim 5, TRAN teaches wherein the relational connection between components establishes the claims structure of the patent application (relationship between component in the data structure: para 0101 and fig. 4).

With respect to claims 7-10, TRAN teaches a system for drafting a patent application as discussed in claim 1.

TRAN teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim tree. The user such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, para 0052) and including at the step 312, the system diagramming the elements of a claim (para 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (para 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the link(s) are hyperlinks; wherein the document and diagram are capable of being output into another software program; wherein the document and diagram axe exportable in HTML format; and wherein the document and diagram are exportable in XML format as claimed.

However, RIVETTE teaches hyperlinking using a linked list of nodes for switching to view the desired component (para 1231-1233; also para 1236-1240); software

programs for outputting (para 0405, 0667 and 1705); and mark-up format or data such as HTML or XML (para 0605-0606, 0656, 0668 and 1250).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a source patent and claim as well (RIVETTE's para 1368-1368; fig. 164 and 185), into the system of TRAN for the purpose of having tools including modules to track and process of Patent or Intellectual property related transaction such as license agreements, therefore, enabling user to use automated tools that automatically process patent related information for making corporate business decision (RIVETTE's para 0003-0008 and 0020-0021).

With respect to claim 11, TRAN teaches a method for drafting a patent application (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: para 0006, 0010 and 0132-0133) comprising the steps of:

entering information relating to components of a patentable invention by at least one user; automatically generating a visual diagram of the components of the invention in a hierarchical relational diagram, wherein the visual diagram is a diagrammatic representation of an invention, wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the invention based upon the user inputted information, and automatically generating a document for

filing as a patent application, including specification and claims, based upon the user inputted information and additional text-based detailed information that is organized consistent with the diagram; wherein the hierarchical component categorization includes at least one key component and at least one subcomponent related thereto; and the at least one user viewing the diagram and text-based information in a tangible medium, wherein the diagrammatic representation of the components and sub-components together provides an indication of what may be claimed in a patent application (inputting from one of client computers: fig. 1, items 104 and 106, para 0035; using graphical user interface and software for assisting the user in generating a patent application: para 0042-0043 and fig. 2A and 2C; see fig. 3B a claim tree, para 0068; automatically generating a patent application: fig. 2's para 0042; technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, para 0008, 0016, 0046 and 0101-0103; independent claims and dependent claims: in fig. 3B claim tree and para 0053-0054; and the claim tree is displayed on the desktop screen, output device: para 0127 and fig. 3B; and computer-readable medium such as a disk: para 0049).

TRAN teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim

tree. The user such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, para 0052) and including at the step 312, the system diagramming the elements of a claim (para 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (para 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the diagrammatic representation comprises graphical component structure and textual component content wherein the textual component is positioned within the graphical component structure for each component associated with each component such that for each component, the graphical component Structure includes the textual component content wherein the textual component and the diagram components are automatically directly linked by being visually integrated with one another within the diagrammatic representation as claimed.

However, RIVETTE teaches image file and text file are presentations of patent (para 0429); the patent is represented by icon (para 0980 and fig. 73 and 164); claim tree (fig. 185; para 1368-1369); hyperlinking using a linked list of nodes for switching to view the desired component (para 1231-1233; also para 1236-1240). This is the same as the graphical component of a patent including drawings, claims, abstract, summary

and detail specification and is illustrated and displayed under a hierarchical tree with graphical component structure (see figs 164 and 185) and classification or categorization the patent/document (para 0727, 1434, and 2080).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a source patent and claim as well (RIVETTE's para 1368-1368; fig. 164 and 185), into the system of TRAN for the purpose of having tools including modules to track and process of Patent or Intellectual property related transaction such as license agreements, therefore, enabling user to use automated tools that automatically process patent related information for making corporate business decision (RIVETTE's para 0003-0008 and 0020-0021).

With respect to claim 12, TRAN teaches further including the step of: at least one user entering diagram verbiage by drafting the text-based detailed description or verbiage of the specification section of the application for each component of the diagram wherein the text-based description and the diagram verbiage are automatically directly linked by being visually integrated with one another where the text associated with each component is included only within the diagram section for that component (a process performed by the software for assisting the user in generating a patent application: figs. 2's and 3B).

With respect to claim 13, TRAN teaches further including the step of: at least one user inputting additional components selected from the group consisting of key

components, subcomponents, and sub-subcomponents (a patent application has background, summary, description, drawings and claims components or such as one independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: para 0068; also see para 0008 and 0016).

With respect to claim 14, TRAN teaches further including the steps of: modifying any previously inputted components within the diagram; and the system automatically updating the diagram and relational information to those modified components (the text of a patent application is enabling to update or edit: para 0044 and claim tree is also able to move or to modify (drag/drop claims): para 0068).

With respect to claim 15, TRAN teaches further including the step of: automatically generating a patent application based upon the inputted information and the hierarchical diagram, including specification and claims (such as one independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: para 0068 or a patent application has background, summary, description, drawings and claims components: para 0008, 0016 and 0044-0045).

With respect to claim 16, TRAN teaches a system for mapping technology using at least one computing device (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: para 0006, 0010 and 0132-0133), comprising:



at least one input device connected to the at least one computing device for inputting information from at least one user (inputting from one of client computers: fig. 1, items 104 and 106, para 0035);

at least one processing means for automatically generating a diagrammatic representation of a technology (using graphical user interface and software for assisting the user in generating a patent application: para 0042-0043 and fig. 2A and 2C), wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the technology based upon the information inputted by the at least one user (fig. 3B a claim tree, para 0068; automatically generating a patent application: fig. 2's para 0042; technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, para 0008, 0016, 0044-0046 and 0101-0103; and independent claims and dependent claims: in fig. 3B claim tree and para 0053-0054); and

at least one output device connected to the at least one computing device for outputting the automatically generated diagrammatic representation of a technology (the claim tree is displayed on the desktop screen, output device: para 0127 and fig. 3B).

TRAN teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim

tree. The user such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, para 0052) and including at the step 312, the system diagramming the elements of a claim (para 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (para 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the diagrammatic representation comprises graphical component structure and textual component content associated with each component such that for each component, the graphical component Structure for each component includes the textual component content for that component only as claimed.

However, RIVETTE teaches image file and text file are presentations of patent (para 0429); the patent is represented by icon (para 0980 and fig. 73 and 164); claim tree (fig. 185; para 1368-1369); hyperlinking using a linked list of nodes for switching to view the desired component (para 1231-1233; also para 1236-1240). This is the same as the graphical component of a patent including drawings, claims, abstract, summary and detail specification and is illustrated and displayed under a hierarchical tree with graphical component structure (see figs 164 and 185); and mapping patent and

document an classification or categorization the patent/document: para 0727, 1434, and 2080 and mapping: abstract, para 0026, 0067 and 0076 and see figs. 59-60 and 84).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a source patent and claim as well (RIVETTE's para 1368-1368; fig. 164 and 185), into the system of TRAN for the purpose of having tools including modules to track and process of Patent or Intellectual property related transaction such as license agreements, therefore, enabling user to use automated tools that automatically process patent related information for making corporate business decision (RIVETTE's para 0003-0008 and 0020-0021).

With respect to claim 17, TRAN teaches a method for mapping technology (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: para 0006, 0010 and 0132-0133) comprising the steps of:

entering information relating to components of a technology by at least one user; automatically generating a visual diagram of the components of the technology in a hierarchical relational diagram, wherein the visual diagram is a diagrammatic representation of a technology, wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the technology based upon the user inputted reformation, wherein the hierarchical component categorization includes at least one key component and at least one subcomponent

related thereto, and the at least one user viewing the diagram and text-based information in a tangible medium (inputting from one of client computers: fig. 1, items 104 and 106, para 0035; using graphical user interface and software for assisting the user in generating a patent application: para 0042-0043 and fig. 2A and 2C; see fig. 3B a claim tree, para 0068; automatically generating a patent application: fig. 2's para 0042; technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, para 0008, 0016, 0046 and 0101-0103; independent claims and dependent claims: in fig. 3B claim tree and para 0053-0054; and the claim tree is displayed on the desktop screen, output device: para 0127 and fig. 3B; and computer-readable medium such as a disk: para 0049).

TRAN teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim tree. The user such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application, generating a patent application including some technical components such as background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, para 0052) and including at the step 312, the

system diagramming the elements of a claim (para 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (para 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the diagrammatic representation comprises graphical component structure and textual component content associated with each component such that for each component, the graphical component structure for each component includes the textual component content directly related only to that specific component, and outputting a viewable diagram of that categorization wherein each of the components and its corresponding text-based information and its corresponding diagram components are automatically directly linked by being visually integrated with one another within the graphical component structure as claimed.

However, RIVETTE teaches image file and text file are presentations of patent (para 0429); the patent is represented by icon (para 0980 and fig. 73 and 164); claim tree (fig. 185; para 1368-1369); hyperlinking using a linked list of nodes for switching to view the desired component (para 1231-1233; also para 1236-1240). This is the same as the graphical component of a patent including drawings, claims, abstract, summary and detail specification and is illustrated and displayed under a hierarchical tree with graphical component structure (see figs 164 and 185); and mapping patent and document an classification or categorization the patent/document: para 0727, 1434, and 2080 and mapping: abstract, para 0026, 0067 and 0076 and see figs. 59-60 and 84).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a source patent and claim as well (RIVETTE's para 1368-1368; fig. 164 and 185), into the system of TRAN for the purpose of having tools including modules to track and process of Patent or Intellectual property related transaction such as license agreements, therefore, enabling user to use automated tools that automatically process patent related information for making corporate business decision (RIVETTE's para 0003-0008 and 0020-0021).

### **Contact Information**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANH LY whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV (Written Authorization being given by Applicant (MPEP 502.03 [R-2])) or fax to (571) 273-4039 (unofficial fax number directly to examiner's office). The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to:

**Central Fax Center: (571) 273-8300.**

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DEC. 16<sup>th</sup>, 2008

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